

REMARKS

In response to the restriction requirement, Applicant elects claims 1-53 with traverse. Applicant has withdrawn claims 54-56 without prejudice. Applicant has added claims 57-59.

Reconsideration of the restriction requirement is respectfully requested. 37 C.F.R. §1.142 explicitly limits restriction to “two or more independent and distinct inventions claimed in a single application.” In this case, claims 54-56 are “dependent” not “independent” of the invention claimed as set forth in claims 1-53. This is evident from the fact that claims 54-56 are dependent claims that depend either directly or indirectly on claim 49.

In addition to being dependent rather than independent, inventions I and II are not distinct. The method for preparing a dental restorative or prosthesis that is claimed in claims 54-56 cannot be practiced with another materially different product. Claims 54-56 specifically restrict practice of the method to the use of the composition of claim 49.

Furthermore, the polymerizable composition comprising a specified photoinitiator system, as claimed in claims 2-23, 26-36 and 38-53, cannot be used in a materially different process from what is claimed in claims 54-56. While the Examiner is correct in suggesting that the composition could be used in a process for providing a molding, photoresist, or film from the composition, such processes would not be materially different from that claimed in claims 54-56. Namely, the processes would involve exposing the polymerizable composition to light, just as claimed in claims 54-56. The product may be used for different applications than a dental restorative or prosthesis, but the process used to produce the end product from the composition claimed in claims 2-23, 26-36, and 38-53 would not be materially different. See page 22, lines 24-27 of the specification, which describes how to polymerize the cationically polymerizable compositions of the present invention. For the foregoing reasons, inventions I and II are not independent and distinct and therefore should be able to be prosecuted in the same application.

Even if claims 54-56 are considered independent and distinct from claims 1-53, a restriction should not be made. According to MPEP §803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” In the present application, the search and examination of claims 54-56 could be made without serious additional burden beyond that already necessary for claims 1-53.

As to the species restriction under 35 U.S.C. §121, Applicant elects 2-ethyl-9,10-dimethoxyanthracene as the anthracene compound, 4-methylphenyliodonium tetrakis (pentafluorophenyl) borate as the iodonium salt, a ketone as the visible light sensitizer, and an epoxy resin as the cationically polymerizable resin. Applicant further elects a species without filler. This elected species is covered by claims 24, 26, 28-29, 32-33, 36, 57 and 58.

Applicant respectfully traverses the species election under 35 U.S.C. §121. Requiring Applicant to elect a particular anthracene compound, a particular iodonium salt, a particular visible light sensitizer, a particular cationically polymerizable resin, and the presence or absence of a filler is more limiting than the scope of any claim in the present application.

A generic claim, namely claim 57, has been provided, as requested by the Examiner, so as to encompass what is claimed in all of the claims of the application. In addition, claims 58 and 59, which depend from claim 57, have been added so as to cover a photopolymerizable composition and a photopolymerizable composition with a filler. In addition to encompassing claims 58 and 59, the subject matter of claim 57 encompasses the subject matter of claims 1, 24, and 37, which are discussed below, making these claims species of genus claim 57. Further, claims 1, 24, and 37 encompass the subject matter claimed in claims 2-23, 25-36, and 38-56, respectively, as also discussed below.

Claim 1 is directed to a species within the genus of claim 57, namely, an iodonium salt, a visible light sensitizer, a first anthracene that has a light absorption maximum less than about 400 nanometers, and a second anthracene having a particular structure. Claim 2 is directed to a species of the genus of claim 1, namely, a cationic polymerizable resin being added to the photoinitiator system of claim 1 so as to form a photopolymerizable composition. Further, claims 3-23 depend from claim 2 and specify sub-species of the composition claimed in claim 2 including particular cationically polymerizable resins, iodonium salts, visible light sensitizers, and anthracenes.

Claim 24 is directed to a genus of claim 57, namely, an iodonium salt, a visible light sensitizer, and an electron donor comprising an alkoxy substituted anthracene. Claim 25 is directed to a species of the genus of claim 24, namely, a second electron donor of a particular structure being added to the photoinitiator system of claim 24. Claim 26 also is directed to a species of the genus of claim 24, namely, a cationically polymerizable resin being added to the photoinitiator system of claim 24 so as to form a photopolymerizable composition. Further, claims 27-36 depend from claim 26 either directly or indirectly and specify sub-species of the composition claimed in claim 24 including particular cationically polymerizable resins, iodonium salts, visible light sensitizers, and anthracene electron donors.

Claim 37 is directed to a genus of claim 57, namely, an iodonium salt, a visible light sensitizer, and first and second anthracene compounds of particular structures. Claim 38 is directed to a species of the genus of claim 37, namely, a cationic polymerizable resin being added to the photoinitiator system of claim 37 so as to form a photopolymerizable composition. Further, claims 39-53 depend from claim 38 either directly or indirectly and specify sub-species

of the composition claimed in claim 38 including particular cationically polymerizable resins, iodonium salts, visible light sensitizers and anthracenes.

All of the claims in the present application are directed to a photoinitiator system that includes an iodonium salt, a visible light sensitizer and an anthracene having particular substituents. In fact, the anthracene claimed in claim 24 is among the anthracene compounds claimed in claims 1 and 37. The invention is the combination of particular anthracene compounds with an iodonium salt and a visible light sensitizer. Accordingly, generic claim 57 of the present application should be considered once the initially elected species is determined to be patentable. As discussed above, the remaining claims are species of generic claim 57 and should be considered with generic claim 57.

It is respectfully submitted that the claims are now in condition for allowance and eventual issuance. Such action is respectfully requested. Should the Examiner have any further questions or comments which need be addressed in order to obtain allowance, please contact the undersigned attorney at the number listed below. Please charge any fees required for adding additional claims to Deposit Account No. 19-4409.

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

By: 

Susan Wharton Bell, Reg. No. 41,524
STINSON MORRISON HECKER LLP
1201 Walnut, Suite 2800
Kansas City, MO 64106-2150
Telephone: (816) 842-8600
Facsimile: (816) 691-3495